

REMARKS

At the time of the First Office Action dated June 26, 2007, claims 1-12 were pending and rejected in this application.

On page 2 of the First Office Action, the Examiner objected to the specification. In response, Applicants note that the specification has been amended in the manner suggested by the Examiner.

**CLAIMS 1, 3, 7-8, AND 12 ARE REJECTED UNDER 35 U.S.C. § 102 FOR ANTICIPATION
BASED UPON KIYAMA ET AL., U.S. PATENT NO. 5,642,518**

On pages 2-6 of the First Office Action, the Examiner asserted that Kiyama discloses the invention corresponding to that claimed. This rejection is respectfully traversed.

The factual determination of anticipation under 35 U.S.C. § 102 requires the identical disclosure, either explicitly or inherently, of each element of a claimed invention in a single reference.¹ Moreover, the anticipating prior art reference must describe the recited invention with sufficient clarity and detail to establish that the claimed limitations existed in the prior art and that such existence would be recognized by one having ordinary skill in the art.² As part of this analysis, the Examiner must (a) identify the elements of the claims, (b) determine the meaning of the elements in light of the specification and prosecution history, and (c) identify

¹ *In re Rijckaert*, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); *Perkin-Elmer Corp. v. Computervision Corp.*, 732 F.2d 888, 894, 221 USPQ 669, 673 (Fed. Cir. 1984).

² See *In re Spada*, 911 F.2d 705, 708, 15 USPQ 1655, 1657 (Fed. Cir. 1990); *Diversitech Corp. v. Century Steps, Inc.*, 850 F.2d 675, 678, 7 USPQ2d 1315, 1317 (Fed. Cir. 1988).

corresponding elements disclosed in the allegedly anticipating reference.³ This burden has not been met.

Claim 1

In the second full paragraph on page 3 of the First Office Action, the Examiner asserted the following:

a dictionary of words and phrases (see col. 4, line 60) (e.g. A dictionary is being used when words are divided.) specific to a particular domain associated with said content (see col. 1, lines 4-5) (e.g. It is implied in the reference that keywords associated with a domain type is extracted and is thus specific to a particular domain depending on the word detected).;

Applicants respectfully disagree with the Examiner analysis. The dictionary identified by Kiyama in column 4, line 60 is described as "a general dictionary." On the contrary, Applicants have recited that the claimed dictionary is "specific to a particular domain associated with said content." Applicants respectfully submit that one having ordinary skill in the art would not recognize the teachings of Kiyama as to a general dictionary as identically disclosing a dictionary specific to a particular domain associated with the content, as claimed.

Regarding the "specific to a particular domain associated with said content," the Examiner asserted "[i]t is implied in the reference that keywords associated with a domain type is extracted and is thus specific to a particular domain depending on the word detected." This assertion, even if true, does not lead to the claimed invention. The makeup of the keywords extracted from a particular domain is based upon the content and not necessarily on the dictionary.

³ Lindermann Maschinenfabrik GMBH v. American Hoist & Derrick Co., 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984).

In this regard, it appears that the Examiner may be relying upon the doctrine of inherency. If so, such a reliance upon the doctrine of inherency to disclose that this dictionary is specific to a particular domain associated with the content is misplaced. Inherency may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient to establish inherency.⁴ To establish inherency, the extrinsic evidence must make clear that the missing element must necessarily be present in the thing described in the reference, and that the necessity of the feature's presence would be so recognized by persons of ordinary skill.⁵ Furthermore, reference is made to ex parte Schricker,⁶ in which the Honorable Board of Patent Appeals and Interferences stated the following:

However, when an examiner relies on inherency, it is incumbent on the examiner to point to the "page and line" of the prior art which justifies an inherency theory. Compare, In re Rijckaert, 9 F.3d 1531, 1533, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (when the PTO asserts that there is an explicit or implicit teaching or suggestion in the prior art, it must indicate where such a teaching or suggestion appears in the prior art); In re Yates, 663 F.2d 1054, 107, 211 USPQ 1149, 1151 (CCPA 1981).

The Examiner did not discharge that burden of indicating where such a teaching appears in the prior art. Thus, the Examiner has not established that this limitation is inherently disclosed by Kiyama. In this regard, the Examiner is also referred to M.P.E.P. § 2112, entitled "Requirements of Rejection Based on Inherency; Burden of Proof."

Claims 3 and 8

In the paragraph spanning pages 4 and 5 of the First Office Action, the Examiner asserted the following:

⁴ In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); In re Oelrich, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981).

⁵ Finnegan Corp. v. ITC, 180 F.3d 1354, 51 USPQ2d 1001 (Fed. Cir. 1999); In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999); Continental Can Co. USA v. Monsanto Co., 20 USPQ 2d 1746 (Fed. Cir. 1991); Ex parte Levy, 17 USPQ2d 1461 (BPAI 1990).

⁶ 56 USPQ2d 1723, 1725 (BPAI 2000).

locating words and phrases in a selected portion of content(see col. 4, lines 58-60), said words and phrases being specific to a particular domain (see col. 1, lines 4-5) (e.g. It is implied in the reference that keywords associated with a domain type is extracted and is thus specific to a particular domain depending on the word detected).;

Applicants respectfully disagree with the Examiner's analysis. Although the Examiner asserts that column 4, lines 58-60 discloses the claimed "locating words and phrases in a selected portion of content," Applicants do not agree. This passage cited by the Examiner refers to "words" but not "phrases." Moreover, the passage cited by the Examiner does not refer to a "selected portion" of content. Regarding the claimed "said words and phrases being specific to a particular domain," Applicants incorporate herein, as also applying to the present rejection, the arguments previously presented with regard to similar terminology found in claim 1.

Therefore, for the above-described reasons, Applicants respectfully submit that the imposed rejection of claims 1, 3, 7-8, and 12 under 35 U.S.C. § 102 for anticipation based upon Kiyama is not viable, and hence, Applicants solicit withdrawal thereof.

CLAIMS 2, 4, AND 9 ARE REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON KIYAMA IN VIEW OF HITA ET AL., U.S. PATENT NO. 6,081,774 (HEREINAFTER HITA)

On pages 6 and 7 of the First Office Action, the Examiner concluded that one having ordinary skill in the art would have been motivated to modify Kiyama in view of Hita to arrive at the claimed invention. This rejection is respectfully traversed.

Claims 2, 4, and 9 respectively depend from independent claims 1, 3, and 8, and Applicants incorporates herein the arguments previously advanced in traversing the imposed rejection of claims 1, 3, and 8 under 35 U.S.C. § 102 for anticipation based upon Kiyama. The secondary reference to

Hita does not cure the argued deficiencies of Kiyama. Accordingly, even if one having ordinary skill in the art were motivated to modify the combination of Kiyama in view of Hita, the proposed combination of references would not yield the claimed invention. Applicants, therefore, respectfully submit that the imposed rejection of claims 2, 4, and 9 under 35 U.S.C. § 103 for obviousness based upon Kiyama in view of Hita is not viable, and hence, Applicants solicit withdrawal thereof.

**CLAIMS 5-6 AND 10-11 ARE REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED
UPON KIYAMA IN VIEW OF KIM ET AL., U.S. PATENT PUBLICATION NO. 2003/0208482
(HEREINAFTER KIM)**

On pages 7-9 of the First Office Action, the Examiner concluded that one having ordinary skill in the art would have been motivated to modify Kiyama in view of Kim to arrive at the claimed invention. This rejection is respectfully traversed.

On page 8 of the First Office Action, the Examiner asserted the following:

Kim does disclose the detecting of words based upon font attributes (see [0031]. It would have been obvious to one of ordinary skilled in the at the time the invention was made to have modified the key word generation taught by Kiyama et at with the inclusion of font detection as taught by Kim et al. The motivation to have combined the two references involves the distinction between important words and unimportant words comparing other words in the text [see Kim et at [0031]], which benefits the keyword generation presented by Kiyama et at by detecting keywords denoted by font to be important.

Applicants respectfully submit that the Examiner's proposed combination is not supported by the teachings of Kiyama and Kim. At the outset, Applicants note that Kim describes locating words based upon font attributes for the purpose of ranking pages in a search engine. This is not comparable to generating a list of keywords for particular content. Also, although the Examiner asserts that distinguishing between important words (i.e., allegedly those words with a variation

in font attributes) and unimportant words, the Examiner has failed to establish that one having ordinary skill in the art, based upon the teachings of Kiyama, would consider that distinguishing words or phrases by importance would be valuable.

Based upon the teachings of Kiyama, apparently all of the words within the content are parsed and the results stored in a word partition table b (see column 4, lines 61-63). Thus, all the words in the content are already added to "said list of keyword candidates." Since, as taught by Kiyama, all the words in the content are added the list of keyword candidates, there would be no need to "[select] a string in said selected portion of content affect by said variation," as claimed, and "[add] said string to said list of keyword candidates." To do so would be redundant, and thus not obvious. Applicants, therefore, respectfully submit that the imposed rejection of claims 5-6 and 10-11 under 35 U.S.C. § 103 for obviousness based upon Kiyama in view of Hita is not viable, and hence, Applicants solicit withdrawal thereof.

Applicants have made every effort to present claims which distinguish over the prior art, and it is believed that all claims are in condition for allowance. However, Applicants invite the Examiner to call the undersigned if it is believed that a telephonic interview would expedite the prosecution of the application to an allowance. Accordingly, and in view of the foregoing remarks, Applicants hereby respectfully request reconsideration and prompt allowance of the pending claims.

Although Applicants believe that all claims are in condition for allowance, the Examiner is directed to the following statement found in M.P.E.P. § 706(II):

Application No.: 10/714,690

When an application discloses patentable subject matter and it is apparent from the claims and the applicant's arguments that the claims are intended to be directed to such patentable subject matter, but the claims in their present form cannot be allowed because of defects in form or omission of a limitation, the examiner should not stop with a bare objection or rejection of the claims. The examiner's action should be constructive in nature and when possible should offer a definite suggestion for correction. (emphasis added)

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

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Respectfully submitted,

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